



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER OF PATENTS AND TRADEMARKS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/396,381	09/15/1999	SHUNPEI YAMAZAKI	0756-2027	7365

31780 7590 05/29/2003

ERIC ROBINSON  
PMB 955  
21010 SOUTHBANK ST.  
POTOMAC FALLS, VA 20165

EXAMINER

ANGEBRANDT, MARTIN J

ART UNIT

PAPER NUMBER

1756

DATE MAILED: 05/29/2003

26

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action**

Application N .

09/396,381

Applicant(s)

YAMAZAKI ET AL.

Examiner

Martin J Angebrannt

Art Unit

1756

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 20 May 2003 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

**PERIOD FOR REPLY** [check either a) or b)]

- a) ☒ The period for reply expires 5 months from the mailing date of the final rejection.  
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.  
ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on \_\_\_\_\_. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.  
2. ☐ The proposed amendment(s) will not be entered because:  
(a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);  
(b) ☐ they raise the issue of new matter (see Note below);  
(c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or  
(d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: \_\_\_\_\_.

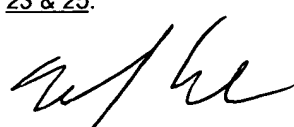
3. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.  
4. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).  
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.  
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.  
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: none.Claim(s) objected to: none.Claim(s) rejected: 1-6,8-20,22-34,36-48 and 50-167.

Claim(s) withdrawn from consideration: \_\_\_\_\_.

8. ☐ The proposed drawing correction filed on \_\_\_\_\_ is a) ☐ approved or b) ☐ disapproved by the Examiner.  
9. ☒ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). 23 & 25.  
10. ☒ Other: See Continuation Sheet

  
Martin J Angebrannt  
Primary Examiner  
Art Unit: 1756

Continuation of 5. does NOT place the application in condition for allowance because: upon reading the rejection, the examiner believes that the rejections not dependent at least in part upon Shinohara et al. JP 01-184722, Kitoh et al. '850, Kugimiya JP 63-003097 or US 6,171,674 MAY BE OBVIATED. A clearer statement is not warranted at this time based upon the issue of trace contaminants raised in the disclosure of Kugimiya JP 63-003097 and the sheer number of claims. The applicant is directed to the note under section 10. The examiner notes that the claims of US 6,171,674 actually recite the same limitations concerning Si and P in some of the claims, therefore the argument is flawed. The IDS's referenced by the applicant are attached or enclosed. The rejections stands for the reasons provided. The issue of the claims embracing trace amounts of these elements MAY PRECLUDE WITHDRAWAL of some of the rejections of record. General motivation for providing Sn, Ge, Si, Pb, F into hard carbon coatings to increase peeling resistance, crack resistance and corrosion resistance are found in Kitoh et al. '850, therefore motivation to modify the references exists. .

Continuation of 10. Other: The examiner notes that claims 6,13,20,27,34,67,78,89,100,111,122,133,144,155 and 166 should be cancelled as failing to further limit the claims upon which they depend. The examiner also notes that the following claims should be limited to depending upon the claims listed immediately after them in parentheses as they fail to further limit the others listed. 66(58,60); 77(69,71); 88(80,82); 99(91,93); 110(102,104); 121(113,115); 132(124,126); 143(135,137); 154(146,148); ~~165~~(157,159). .

*W*  
*5/2/03*